

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

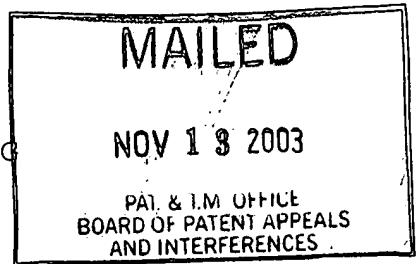
Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte F. ANDREW UBEL,
KURT ALLENBERG, CHARLES C. POLTA,
ANTHONY J. CAMPAGNA and MELVIN Y. WONG

Appeal No. 2003-1123
Application 09/551,706



ON BRIEF

Before COHEN, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

F. Andrew Ubel et al. appeal from the final rejection of claims 1, 2, 4 through 23, 25 through 32, 38 through 46, 61 and 62, all of the claims pending in the application.

THE INVENTION

The invention relates to "apparatus . . . for packaging and storing continuous length, moisture-curable orthopedic splinting/casting product in moisture-proof pouches and

containers" (specification, page 1). Representative claims 1, 25, 42 and 62 read as follows:

1. An apparatus, comprising:

a pouch comprising a first end, a second end, and a pouch length extending therebetween, wherein the pouch further defines an interior; and

a moisture-sensitive product having a continuous length, the product being folded into a packaged configuration comprising a plurality of sections arranged within the interior and along the pouch length, each section comprising at least two folds and a segment spanning therebetween, the segment also extending along the pouch length.

25. An apparatus for storing and dispensing a continuous length of product, the apparatus comprising:

a pouch comprising an interior for receiving and storing a continuous length of moisture-sensitive product, wherein the pouch further comprises a first end; and

a compression device adapted to couple to the pouch proximate the first end, the compression device comprising a first compression member and a second, opposing compression member, the compression members adapted to substantially conform the shape of the first end of the pouch to the shape of the product.

42. A closure apparatus for use with products stored within a flexible pouch, the apparatus comprising:

a compression device comprising two opposing compression members;

a sealing device operatively coupled to the compression device, the sealing device comprising opposing sealing members wherein the sealing members are selectively movable between an open position and a closed position.

62. An apparatus for storing and dispensing a continuous length of moisture-sensitive product, the apparatus comprising:

a pouch comprising an interior for receiving and storing the continuous length of moisture-sensitive product, wherein the pouch further comprises a first end; and

a compression device adapted to couple to the pouch proximate the first end, the compression device comprising a first compressible member and a second, opposing compressible member, the first and second compressible members adapted to substantially conform the shape of the first end of the pouch to the shape of the product.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Ausnit	4,703,518	Oct. 27, 1987
Parker et al. (Parker)	5,003,970	Apr. 2, 1991
Nakamura	5,076,424	Dec. 31, 1991
Cernohous et al., (Cernohous) International Patent Document	WO 96/20884	Jul. 11, 1996

THE REJECTIONS

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Cernohous.

Claims 2, 5 through 9, 13 through 15, 17 through 20 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura.

Claims 1, 2, 4 through 10, 12 through 16, 25 through 28, 32, 38 through 46, 61 and 62 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Parker.

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Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Ausnit.

Claims 11, 21, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 16 and 19) and to the examiner's answer (Paper No. 17) for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Nakamura

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713

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F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Nakamura discloses a dispenser-container for tissues impregnated with liquid cosmetics, medicines, cleaning solutions and the like. The Figure 13 embodiment relied on by the examiner includes a main body 10 for holding the wet tissues 3, a closure member 11 covering the top of the main body, an opening 12 in the main body for dispensing the tissues, a flap 14 for repeatedly opening and sealing the dispensing opening and a mount 19 for hanging the dispenser-container on a wall. Figure 13 shows the wet tissues 3, which may be made of a long continuous sheet 30 having transversely extending perforation lines 31 for separating it into short individual pieces, as having a rope-like form coiled into a rectangular stack within the main body.

Notwithstanding the examiner's finding to the contrary (see pages 4, 8 and 9 in the answer), Nakamura does not meet the limitations in claim 1 requiring the product to comprise a plurality of sections arranged along the pouch length with each section comprising at least two folds and a segment spanning therebetween and also extending along the pouch length. Arguably, Nakamura's coiled rectangular stack of tissues 3 embodies a plurality of sections arranged along the "pouch"

length with each section comprising at least two folds and a segment spanning therebetween. These segments, however, extend transverse to the "pouch" length, and hence do not meet the claim limitation requiring the segments to extend along the pouch length.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Nakamura.

II. The 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Cernohous

Cernohous discloses a dispenser for sorbent nonwoven webs designed to soak up spilled liquids. The Figure 1 embodiment relied on by the examiner, designated by reference numeral 10, comprises a flexible enclosure 14 containing the nonwoven web 12, a manually puncturable region 16 which, when punctured or torn, allows the web to be withdrawn from the enclosure and a reinforcing band 18 surrounding the puncturable region to limit the spread of the puncture. Figure 1 shows the nonwoven web to be disposed within the enclosure in a folded serpentine pattern.

Here again, the examiner's finding (see pages 4 and 9 in the answer) that the reference meets the limitations in claim 1 requiring the product to comprise a plurality of sections arranged along the pouch length with each section comprising at least two folds and a segment spanning therebetween and also

extending along the pouch length is unsound. Depending on the perspective from which it is viewed, Cernohous' nonwoven web embodies either sections arranged along the pouch length or segments spanning two folds and extending along the pouch length, but not both as required by claim 1.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Cernohous.

III. The 35 U.S.C. § 102(b) rejection of claims 2, 5 through 9, 13 through 15, 17 through 20 and 22 as being anticipated by Nakamura

Claims 2, 5 through 9, 13 through 15, 17 through 20 and 22 depend from claim 1. As the subject matter recited in claim 1 distinguishes over Nakamura for the reasons discussed above, so too does the subject matter recited in claims 2, 5 through 9, 13 through 15, 17 through 20 and 22.

Thus, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 2, 5 through 9, 13 through 15, 17 through 20 and 22.

IV. The 35 U.S.C. § 102(b) rejection of claims 1, 2, 4 through 10, 12 through 16, 25 through 28, 32, 38 through 46, 61 and 62 as being anticipated by Parker

Parker discloses a container for storing and dispensing a moisture-curable medical material used to make casts and splints. The Figure 11 through 14 embodiment relied on by the examiner,

designated by reference numeral 30, comprises a moisture-proof container 31 housing the medical material 14, a sleeve 32 on the container having an open end 33 through which the medical material may be dispensed, and a clamp 36 or a pair of "zip-lock" zippers 38 for sealing the open end of the sleeve. The medical material 14 consists of a substrate 16 of a suitable number of overlaid layers of a woven or knitted open fabric, such as fiber glass, contained within a tubular cushioning wrap 18 formed of a soft, non-woven fiber (see column 5, lines 24 through 36).

Figure 14 shows the medical material within the container to be disposed in a cylindrical coil. To obtain a desired length of medical material, a user would remove the clamp or unzip the zippers, grasp the end of the material, withdraw an appropriate length from the opening in the sleeve, cut it, tuck the uncut material back into the sleeve and reseal the opening (see column 6, lines 56 through 64).

The examiner considers (see pages 5, 7 and 9 in the answer) that Parker meets the limitations in claim 1, and the corresponding limitations in independent claim 61, requiring the product to comprise a plurality of sections arranged along the pouch length with each section comprising at least two folds and a segment spanning therebetween and also extending along the

pouch length by virtue of the depiction in Parker's Figure 13 of the overlaid layers in the medical material substrate. The examiner's position that these overlaid layers constitute a plurality of sections arranged along the pouch length rests on an unreasonable interpretation of both the claim language at issue and the disclosure of Parker.

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1 and 61, or of claims 2, 4 through 10 and 12 through 16 which depend from claim 1, as being anticipated by Parker.

With regard to independent claims 25, 42 and 62, the dispositive issues as framed and argued by the appellants (see pages 16 through 19 in the main brief and page 3 in the reply brief) are whether Parker meets the limitations in claims 25 and 62 requiring a compression device "adapted to substantially conform the shape of the first end of the pouch to the shape of the product" and the limitations in claim 42 requiring both a compression device and a sealing device. The examiner finds that these limitations are met by Parker's clamp 36 (see pages 6 and 7 in the answer). The appellants dispute this finding with respect to claims 25 and 62 on the basis that clamp 36 is not adapted to substantially conform the shape of the first end of the pouch to

the shape of the product because it must be removed prior to dispensing the product, and with respect to claim 42 on the similar basis that the clamp 36 must be removed prior to dispensing the product and acts to seal only after the product is dispensed.

The examiner's position here is well founded, and the appellants' is not. With regard to claims 25 and 62, the illustrations of Parker's container or pouch 31, product 14 and clamp 36 in Figures 11 through 14 provide reasonable support for the examiner's determination that the clamp 36 is adapted to substantially conform the shape of the first end of the pouch to the shape of the product. Neither of these claims requires the compression device recited therein to be engaged with the pouch or product during the dispensing of the product as urged by the appellants. As for claim 42, the examiner's finding (see page 6 in the answer) that the curved arms of the clamp 36 constitute a compression device and the flat pressing sections of the clamp 36 constitute a sealing device as broadly recited in claim 42 is reasonable on its face. Here again, claim 42 does not actually require the closure apparatus recited therein to be engaged with a pouch or product during dispensing.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 25, 42 and 62 as being anticipated by Parker.

Claim 28 depends indirectly from claim 25 and further defines the apparatus recited in the parent claim as comprising a sealing device which forms a parallel closure device. The examiner has not cogently explained, and it is not apparent, how Parker's clamp 36 embodies both a compression device which is adapted to substantially conform the shape of the first end of the pouch to the shape of the product as recited in claim 25 and a sealing device which forms a parallel closure device as recited in claim 28.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 28 as being anticipated by Parker.

Claim 32 depends indirectly from claim 25 and further requires compression members of the compression device recited in the parent claim to conform the shape of the first end of the pouch to the shape of the product as the product is dispensed from the pouch through the opening. The Parker reference, which teaches that the clamp 36 is removed when the product is dispensed from the pouch, does not provide any reasonable basis

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for finding that the clamp 36 is structurally capable of performing the function recited in claim 32.

Thus, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 32 as being anticipated by Parker.

We shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 26, 27 and 38 through 41 as being anticipated by Parker since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 25 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Claim 43 depends from claim 42 and requires a frame assembly operatively coupling the compression device to the sealing device. Notwithstanding the examiner's finding to the contrary, Parker's clamp 36 does not embody a compression device and sealing device as recited in the parent claim and a frame assembly as recited in claim 43.

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 43 as being anticipated by Parker.

We shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 44 through 46 as being anticipated by Parker since the appellants have not challenged such with any reasonable

specificity, thereby allowing these claims to stand or fall with parent claim 42 (see Nielson, supra).

V. The 35 U.S.C. § 103(a) rejection of claim 23 as being unpatentable over Nakamura

Claim 23 depends indirectly from independent claim 1 and requires a suspension member located proximate the second end of the pouch. Even if the examiner's conclusion that it would have been obvious to provide Nakamura's dispenser-container with such a suspension member is accepted at face value, Nakamura would still lack response to the above discussed product limitations in parent claim 1.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 23 as being unpatentable over Nakamura.

VI. The 35 U.S.C. § 103(a) rejection of claim 29 as being unpatentable over Parker in view of Ausnit

Claim 29 depends from claim 28 and further defines the parallel closure device recited in the parent claim as comprising male and female members, with the female member adapted to receive the male member such that the pouch is trapped therebetween. Although the Ausnit reference discloses such male and female members, the combined teachings of Parker and Ausnit would not have suggested incorporating Ausnit's closure device

into Parker's clamp 36 to produce a tighter seal as urged by the examiner. Furthermore, Ausnit does not remedy the above discussed deficiencies of Parker relative to parent claim 28.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 29 as being unpatentable over Parker in view of Ausnit.

VI. The 35 U.S.C. § 103(a) rejection of claims 11, 21, 30 and 31 as being unpatentable over Parker

Claims 11 and 21 depend indirectly from independent claim 1 and claims 30 and 31 depend from independent claim 25. Parker lacks response to the above noted product limitations in claim 1 and furthermore does not provide the factual basis necessary to support the examiner's conclusion of obviousness with respect to the particular subject matter recited in claims 11, 21, 30 and 31.

Thus, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 11, 21, 30 and 31 as being unpatentable over Parker.

SUMMARY

In light of the foregoing discussion, the decision of the examiner:

- a) to reject claim 1 under 35 U.S.C. § 102(b) as being anticipated by Nakamura is reversed;

- b) to reject claim 1 under 35 U.S.C. § 102(b) as being anticipated by Cernohous is reversed;
- c) to reject claims 2, 5 through 9, 13 through 15, 17 through 20 and 22 under 35 U.S.C. § 102(b) as being anticipated by Nakamura is reversed;
- d) to reject claims 1, 2, 4 through 10, 12 through 16, 25 through 28, 32, 38 through 46, 61 and 62 under 35 U.S.C. § 102(b) as being anticipated by Parker is affirmed with respect to claims 25 through 27, 38 through 42, 44 through 46 and 62, and reversed with respect to claims 1, 2, 4 through 10, 12 through 16, 28, 32, 43 and 61;
- e) to reject claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura is reversed;
- f) to reject claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Ausnit is reversed; and
- g) to reject claims 11, 21, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Parker is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



IRWIN CHARLES COHEN
Administrative Patent Judge



JOHN P. MCQUADE
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

JPM/kis

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ATTN: STEPHEN W. BAUER, ESQ.
OFFICE OF INTELLECTUAL PROPERTY COUNSEL
3M INNOVATIVE PROPERTIES COMPANY
P. O. BOX 33427
ST. PAUL, MN 55133-3427